

Amendment and Response

Applicant: Eric E. Aanenson

Serial No.: 10/773,504

Filed: February 6, 2004

Docket No.: A711.100.101 (Previously 89822)

Title: DEEP SEA FISHING LURE

REMARKS

The following remarks are made in response to the Non-Final Office Action mailed September 28, 2007. Claims 16, 17, and 23 have been cancelled. Claims 25-35 have been allowed. Claims 1-4, 6, 8-15, 18-22, 24, and 36-43 were rejected. Claims 5 and 7 have been objected to. With this Response, claim 20 has been amended. Claims 1-4, 6, 8-15, 18-22 and 24-39 remain pending in the application and are presented for reconsideration and allowance.

REJECTIONS UNDER 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, each of these three criteria must be met: (1) there must be some suggestion or motivation to modify or combine the reference teachings; (2) there must exist a reasonable expectation of success; and (3) the references must teach or suggest all of the claim limitations. MPEP § 2143.

Patent Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. § 103. MPEP § 2141. The four *Graham* factual inquiries that provide the basis for an obviousness determination include: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In addition, the Manual of Patent Examining Procedure at Section 2141 provides these basic tenants of patent law that must be adhered to:

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- A. The claimed invention must be considered as a whole;
- B. The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- C. The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- D. Reasonable expectation of success is the standard with which obviousness is determined.

The US Patent & Trademark Office has published guidelines, effective October 10, 2007, that will assist Office personnel in making a "proper determination of obviousness under 35 U.S.C. § 103." Fed. Reg., Vol. 72, No. 195. The guidelines recognize that differences between the cited art and the claimed invention are likely to exist, and provides that "The gap between the prior art and the claimed invention may not be 'so great as to render the [claim] nonobvious to one reasonably skilled in the art.'" *Dann v. Johnston*, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976).

It is believed that the diverse collection of cited references include a gap in their respective disclosures that is so great that no basis exists for establishing a *prima facie* case of obviousness in light of the cited references.

Recently, the Supreme Court offered guidance on how references should be viewed when conducting an obviousness determination. The Supreme Court's position is: "A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.

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Ct. 1727, 1731; 82 USPQ2d 1385, 1389 (2007)(*emphasis added*). In making this point, the Court noted that “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 127 S. Ct. at 1738; 82 USPQ2d at 1396 (*emphasis added*).

In addition, the Court in the *KSR* decision offers this reminder: “A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR*, 127 S. Ct. at 1739; 82 USPQ2d at 1397 (citing to *Graham*, 38 U.S. 1, 36 in warning against a temptation to read into the prior art the teachings of the invention at issue and instructing courts to guard against slipping into the use of hindsight).

Rejection of Claims 36-39

In maintaining this rejection from the prior Office Action, it appears that the Examiner ignored the discussion with respect to this rejection in Comments Supporting Pre-Appeal Brief Request for Review.

Claims 36-37 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima in view of King, US Patent No. 6,647,659. After acknowledging that “Fima does not disclose a rechargeable battery pack for the display lights installed in the housing and a leader tube, passing centrally through the body to the battery pack, that forms part of recharging circuit,” it is contended that King discloses these elements.

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King does not disclose a leader tube. Reference numeral 35 in King is for a switch housing in which metal ball bearing 37 moves. As is discussed and illustrated in the present application and as is common knowledge to those of ordinary skill in this field, a leader tube is adapted to receive a leader wire.

Accordingly, it is submitted that the Examiner has failed to make a *prima facie* showing of obviousness for claim 36 or claims 37-39, which depend from claim 36. Reconsideration and withdrawal of this rejection are respectfully requested.

Rejection of Claims 1-4, 6, 8-14 and 24

Claims 1-4, 6, 12-14 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima, US Patent No. 4,250,650 in view of Treon, US Patent No. 4,799,327; Garr, US Patent No. 4,727,674 and Bomann, US Patent No. 6,393,757. After acknowledging various aspects of the claimed invention that the primary reference (Fima) does not disclose, it was contended that that it would have been obvious to combine individual features from each of the secondary references with the Fima fishing lure to produce the claimed invention.

In the Office Action, it is acknowledged that Fima does not disclose the following elements:

- (1) a first light source is a linear bank of lights
- (2) a circular bank of display lights installed in the housing aft of the first light sources
- (3) a jacket that is removable and interchangeable.

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By referencing individual patents that separately disclose each of the preceding elements and contending that it would have been obvious to combine them with the Fima fishing lure, the Examiner ignores the fact that the claimed fishing lure with the combined features has produced exceptional results when used in developmental testing.

In particular, when recently used on a fishing trip off the coast of New Zealand at a depth of about 1,000, the claimed fishing lure caught 3 very large swordfish over a period of about 36 hours. For comparison, during similar fishing trips over a period of about one year only 13 swordfish were caught in similar locations using a variety of other commercially available lures. The fisherman using the claimed fishing lure when asked about the tremendous success could only attribute it to the features of the claimed fishing lure.

The Examiner has impermissibly used the hind sight offered by viewing the claims of the present application as a road map to locate individual elements from the prior art. Such a technique is not permitted under the *KSR* decision.

In light of the preceding comments, it is submitted that there is no teaching or suggestion to combine the elements from the four individual patents as is done by the claimed invention. Reconsideration and withdrawal of the rejection of independent claims 1 and 24 as well as claims 2-4, 6, and 8-14 that depend from claim 1.

In addition to the fact that claim 8 depends from claim 1, which is non-obvious for the reasons set forth above, it is submitted that a *prima facie* case of obviousness has not been established with respect to claim 8. As discussed in lines 16-18 of page 5:

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The interior of the housing 23 is filled or potted solid with a clear polyester resin 26 to hold the various components in place as well as to protect them from the effects of high pressure at sea depths and from the corrosive effects of salt water.

Liebert discloses forming a body 10 from a clear or substantially transparent plastic such as clear epoxy resin. A pupil 11a is provided just beneath the surface of the body 10 to provide the body 10 with an appearance that is similar to an eye.

Nowhere in Liebert is it taught or suggested to enclose electrical components of the fishing lure in a clear epoxy resin. As is discussed above, encapsulating the components of the fishing lure in the clear epoxy resin protects the components from the high pressure at sea depths. The clear epoxy resin also protects the electrically operated components in the fishing lure from corrosion caused by salt water.

Additionally, none of the other references cited by the Examiner teach or suggest enclosing the electrical components in the clear epoxy resin. None of the fishing lures described in the cited references appears to be intended for use in deep sea fishing, as is the claimed fishing lure. At depths of in excess of 1,000 feet, the pressures exert on objects such as fishing lures is much greater than the pressures exert near the surface of the water.

In view of the preceding comments, it is submitted that claim 8 is not obvious when viewed in light of the combination of references cited by the Examiner. Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 9-11 were rejected based upon additional references. For the reasons set forth above with respect to claim 1, it is submitted that claims 9-11 are also non-obvious when viewed in light of the cited references as none of the additional references overcome the

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deficiencies discussed above. Reconsideration and withdrawal of the rejections of claims 9-11 are respectfully requested.

Rejection of Claims 15 and 18-22

Claims 15 and 18-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima in view of Garr and Bomann. Similar to the rejection of claim 1 that is discussed above, the Examiner notes individual deficiencies in Fima and then cites unrelated, individual references that separately disclose the features omitted in the Fima fishing lure. The Examiner then contends that it would be obvious to make the claimed combination.

By referencing individual patents that separately disclose each of the preceding elements and contending that it would have been obvious to combine them with the Fima fishing lure, the Examiner ignores the fact that the claimed fishing lure with the combined features has produced exceptional results when used in developmental testing.

As is discussed above with respect to claim 1, the claimed invention has produced remarkable results when used in deep sea fishing at depths of around 1,000 feet producing in a single 36 hour fishing trip approximately $\frac{1}{4}$ of the swordfish that are typically caught over a single year by fishing boats in similar locations using similar equipment with the exception of the claimed fishing lure.

The Examiner has impermissibly used the hind sight offered by viewing the claims of the present application as a road map to locate individual elements from the prior art. Such a technique is not permitted under the KSR decision.

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In light of the preceding comments, it is submitted that there is no teaching or suggestion to combine the elements from the three individual patents as is done by the claimed invention. Reconsideration and withdrawal of the rejection of independent claim 15 as well as claims 18-22 that depend from claim 15.

In addition to the fact that claim 20 is non-obvious because it depends from claim 15, it is also submitted that claim 20 references enclosing the electrical components of the fishing lure in clear epoxy resin to fill the interior space of the fishing lure, as is discussed in more detail above with respect to claim 8. For these reasons, it is submitted that claim 20 is independently allowable over the cited references. Reconsideration and withdrawal of the rejection of claim 20 are respectfully requested.

Claims 21-22 were rejected based upon additional references. For the reasons set forth above with respect to claim 15, it is submitted that claims 21-22 are also non-obvious when viewed in light of the cited references as none of the additional references overcome the deficiencies discussed above. Reconsideration and withdrawal of the rejections of claims 21-22 are respectfully requested.

Allowable Subject Matter

The Examiner objected to claims 5 and 7 for being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-4, 6, 8-15, 18-22 and 24-39 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-4, 6, 8-15, 18-22 and 24-39 are respectfully requested.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to Michael A. Bondi at Telephone No. (612) 767-2512, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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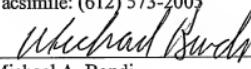
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